



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,091	09/04/2003	James J. LeKachman	47004.000216	5822

21967 7590 09/19/2007  
HUNTON & WILLIAMS LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
1900 K STREET, N.W.  
SUITE 1200  
WASHINGTON, DC 20006-1109

EXAMINER
----------

TRAN, HAI

ART UNIT	PAPER NUMBER
----------	--------------

3693

MAIL DATE	DELIVERY MODE
-----------	---------------

09/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/654,091

Applicant(s)

LEKACHMAN, JAMES J.

Examiner

Hai Tran

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☒ Claim(s) 4,13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/4/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/13/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This is the first Office Action in response to the application filed on September 4, 2003, titled: "System And Method For Financial Instrument Pre-qualification And Offering".
2. Claims 1-31 are pending in this application and have been examined.

### ***Priority***

3. This application claims the benefit of U.S. Provisional Patent Application No. 60/407,696, filed on 9/4/2002.

### ***Drawings Objections***

4. The drawings are objected to because Figures 1 and 2 fail to show details as described in the specification. The elements are not labeled.
5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

Art Unit: 3693

renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

6. Claims 4 and 13 are objected to because of the following informalities:
7. Claim 4 recites the term "CTI" needs to be spelled out.
8. Claim 13 recites the phrase "The method of claim 12" is incorrect because claim 12 says it is a system claim.
9. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
11. Claims 1-11, 12-13, 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically,
12. **As to claim 1:**
13. Claim 1 is rejected because line 6 recites the phrases "a first interface unit for interfacing wit the receiving unit and for communicating at least some of the information

Art Unit: 3693

to portions of the system; and” and line 8 recites “a second interface unit for communicating at least some consumer data to at least one third party”. It is unclear how the first interface unit passes the information to the second interface unit, or how the second interface unit receives the information.

14. Claim 1 is rejected because it recites the phrase “a consumer having a unique identifier who contacts the system is offered at least one of pre-qualified financial instruments” is unclear. It is unclear how the consumer is offered a financial instrument.

15. Claims 2-11 are also rejected because of their dependency on claim 1.

16. **As to claims 3 and 4:**

17. Claims 3 and 4 are rejected because claim 3 recites the “first interface unit” as “a human operator” and claim 4 recites the “first interface unit” as “a processor”. It is unclear if the first interface unit is “a human operator” or “a processor”.

18. **As to claims 8, 9, 12:**

19. Claims 8, 9, 12 are rejected because they recite the terms “suppression database” and “suppression information” are not definite because a person of ordinary skill in the art would be uncertain what “suppression database” or “suppression information” mean since they are unclear exactly what they mean. The metes and bounds of the claim cannot be understood because of the lack of definiteness in the claim.

20. Claim 13 is also rejected because of its dependency on claim 12.

Art Unit: 3693

21. **As to claims 10, 28, 29:**

22. Claim 10, 28, and 29 are rejected because they recite the term "substantially" is unclear because a person of ordinary skill in the art cannot ascertain exactly what it means. The metes and bounds of the claim cannot be understood because of the lack of definiteness in the claim.

23. Claim 30 is also rejected because of its dependency on claim 28.

24. For the purpose of examination, Examiner interprets the limitation in light of this 112, second paragraph rejection.

***Claim Rejections - 35 USC § 103***

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 14-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarin et al. (U.S. Patent Application Publication No. 2002/0138418) ("Zarin") in view of Cunningham (U.S. Patent No. 6,014,645) ("Cunningham").

27. **Regarding claim 14**, Zarin teaches a method for offering financial instruments to pre-qualified consumers (see Zarin, Abstract), comprising:

receiving information related to personal identification information of a consumer (see Zarin, paragraph 51, figure 2/element 202);

inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with a financial institution (see Zarn, paragraph 52-53, figure 2/elements 204, 206); and

offering the consumer the financial instrument for which he or she is pre-qualified, if the third party confirms that the consumer is pre-qualified for a financial instrument (see Zarin, paragraph 57, figure 2/elements 224, 226),

wherein the third party maintains consumer information relating to consumer pre-qualification for financial instruments (see Zarin, paragraphs 48-49, figure 1B/elements 112, 114), wherein further the standards for the consumer pre-qualification are set by the financial institution (see Zarin, paragraph 48, figure 1B/element 114 where it says "financial account approval server". Also see Cunningham, col. 4, lines 23-43 including the matrix, figure 2/element 50).

Although Zarin does not expressly disclose the financial institution standards for consumer pre-qualification, it specifically discloses a "financial account approval server". The Examiner notes that the "financial account approval server" would have included or would have easily been modified to include the standards for the consumer pre-qualification. However, regardless Zarin teaches a financial account approval server or not, Cunningham teaches bank selection criteria for consumer pre-qualification (see col. 4, lines 23-43 including the matrix, figure 2/element 50). Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of Cunningham, related to bank selection criteria, in the Zarin's invention to

Art Unit: 3693

offer an improved system for more efficiently processing consumer request as described in Zarin in (paragraph 64).

28. **Regarding claim 15**, Zarin does not expressly teach such feature. Cunningham teaches pre-qualification of the consumer comprises checking at least one of the credit rating of the consumer, the income level of the consumer, the debt level of the consumer and the payment history of the consumer with the financial institution (see col. 4, lines 9-14, figure 2/element 42, col. 5, lines 24-31, figure 3/element 66).

29. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of Cunningham, related to bank selection criteria, in the Zarin's invention to offer an improved system for more efficiently processing consumer request as described in Zarin in (paragraph 64).

30. **Regarding claim 16**, Zarin teaches that the pre-qualification of the consumer occurs prior to receipt of the consumer contact (see paragraph 16, where it says "Once the accessing party ...").

31. **Regarding claim 17**, Zarin teaches that the third party maintains consumer information in files indexed by a unique identifier (see paragraph 11, where it says "a pre-approval code").

32. **Regarding claim 18**, Zarin teaches the unique identifier relates to the personal identification information of the consumer (see paragraph 11, where it says "individually tailored").

33. **Regarding claim 19**, Zarin does not expressly teach such feature. Cunningham teaches offering the financial instrument to the consumer only if the consumer credit



rating substantially at the time of the consumer contact meets or exceeds a pre-determined condition (see col. 4, lines 24-43 including the matrix, figure 2/element 50).

34. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of Cunningham, related to bank selection criteria, in the Zarin's invention to offer an improved system for more efficiently processing consumer request as described in Zarin in (paragraph 64).

35. **Regarding claim 20**, Zarin teaches that the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive (see paragraph 11, where it says "pre-existing" or "prospective" card holder).

36. **Regarding claim 21**, Zarin teaches that the financial instrument comprises at least one of a car loan, boat loan, loan on investment property, margin account, business loan, second mortgage, home equity line of credit, consumer loan, transaction card, credit card, loyalty card, co-branded credit card, debit card, rewards card, smart card, mutual fund or insurance (see paragraph 26).

37. **Regarding claim 22**, Zarin teaches that the consumer is offered the financial instrument only if one or more pre-determined conditions related to the purpose or channel of the consumer contact are met (see paragraphs 38-39).

38. **Regarding claim 23**, Zarin teaches that the purpose of the consumer contact comprises a purchase from a merchant (see paragraph 10, the consumer is a pre-existing enrollee").

39. **Regarding claim 24**, Zarin teaches that the channel of the consumer contact comprises one of a communication from a business partner of the financial institution or

a communication directly to the financial institution (see paragraph 28, where it says "or a third party issuers under contract with financial institutions").

40. **Regarding claim 25**, Zarin teaches that the channel of the consumer contact further comprises one of a telephone call or contact over a computer network (see paragraph 38).

41. **Regarding claim 26**, Zarin teaches that further comprising offering the financial instrument only upon the acceptance of any terms and conditions related to the financial instrument by the consumer (see paragraphs 54- 55, where it says "allowing the accessing party to verify or change", figure 2/element 216).

42. **Regarding claim 27**, Zarin teaches that further comprising offering the financial instrument to the consumer only if the identity of the consumer is authenticated (see paragraph 55, where it says "accessing party is eligible for receipt of a customer offer").

43. **Regarding claim 28**, Zarin teaches that wherein authenticating the consumer comprises favorable comparison of stored consumer information to consumer information received substantially at the time of consumer contact (see paragraph 55, where it says "accessing party access code be first checked against the distinct files stored on a pre-approval database", figure 2/element 214).

44. **Regarding claim 29**, Zarin teaches wherein the consumer information received substantially at the time of consumer contact comprises at least one of a calling telephone number, a PIN, a password, a biometric or any other information known or held by the consumer and generally not known to the public that can be used to authenticate the consumer (see paragraphs 27 and 51).

Art Unit: 3693

45. **Regarding claim 30**, Zarin teaches wherein authentication is performed by the third party (see paragraph 28, where it says “or a third party under contract with financial institution”).

46. **Regarding claim 31**, this claim is similar to claims 14, 20 and has similar limitations. Hence, it is rejected under the same rationale provided in claims 14-30 above.

47. **Regarding claims 1-13**, these are the computer system claims including the necessary apparatus and programs for implementing Applicant's invention and have similar limitations with claims 14-31. Hence, they are rejected under the same rationale provided in claims 14-31.

48. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

**Conclusion**

49. Claims 1-31 are rejected.

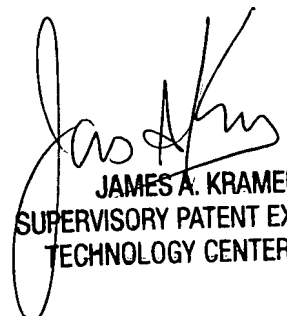
50. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7364.

The examiner can normally be reached on M-F, 9-4 PM.

51. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

52. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT

 5-17-07  
JAMES A. KRAMER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600